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| APPLICATION NO.                                                                       | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/647,981                                                                            | 05/07/2001  | Charles D.Y. Sia     | 1038-1086 MIS:jb    | 6174             |
| 24223                                                                                 | 7590        | 11/17/2004           | EXAMINER            |                  |
| SIM & MCBURNEY<br>330 UNIVERSITY AVENUE<br>6TH FLOOR<br>TORONTO, ON M5G 1R7<br>CANADA |             |                      | PARKIN, JEFFREY S   |                  |
|                                                                                       |             |                      | ART UNIT            | PAPER NUMBER     |
|                                                                                       |             |                      | 1648                |                  |

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                             |                                   |  |
|------------------------------|---------------------------------------------|-----------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/647,981        | <b>Applicant(s)</b><br>SIA ET AL. |  |
|                              | <b>Examiner</b><br>Jeffrey S. Parkin, Ph.D. | <b>Art Unit</b><br>1648           |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

Serial No.: 09/647,981  
Applicants: Sia, C. D. Y., et al.

Docket No.: 1038-1086  
Filing Date: 05/07/01

## Response to Communication

### *Status of the Claims*

Acknowledgement is hereby made of receipt and entry of the communication filed 26 March, 2004. Claims 1-11 are pending in the instant application.

### *35 U.S.C. § 112, Second Paragraph*

Claims 1-11 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims contain the limitation "a T-cell inducing HIV-derived molecule" which is vague and indefinite. First, the precise immunological properties of this compound are not readily manifest. Does the molecule induce a humoral, cell-mediated, T-helper cell, or some other response? Second, the precise chemical nature of this compound is not readily manifest. Does the compound reference a peptide carrying a particular epitope, an adjuvant, or some other molecule? Appropriate correction and clarification are required.

Applicants traverse and submit that the claim language is clear and unambiguous. The examiner does not concur with this assessment. As applicants point out, the disclosure describes such molecules as HIV-1-derived polypeptides. However, the term molecule encompasses numerous other compounds that are not proteinaceous in structure. Thus, the phrase is confusing since the precise structure of these molecules is not readily apparent. Applicants may obviate the rejection by directing the claim language toward HIV-1-derived polypeptides comprising T-cell epitopes. The nature of the epitope should also be clearly defined.

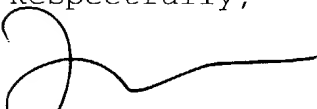
Serial No.: 09/647,981  
Applicants: Sia, C. D. Y., et al.

### **Correspondence**

Any inquiry concerning this communication should be directed to Jeffrey S. Parkin, Ph.D., whose telephone number is (571) 272-0908. The examiner can normally be reached Monday through Thursday from 10:30 AM to 9:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, James C. Housel, can be reached at (571) 272-0902. Direct general status inquiries to the Technology Center 1600 receptionist at (571) 272-1600. Formal communications may be submitted through the official facsimile number which is (703) 872-9306. Hand-carried formal communications should be directed toward the customer window located in Crystal Plaza Two, 2011 South Clark Place, Arlington, VA. Applicants are directed toward the O.G. Notice for further guidance. 1280 O.G. 681. Informal communications may be submitted to the Examiner's RightFAX account at (571) 273-0908.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully,



Jeffrey S. Parkin, Ph.D.  
Patent Examiner  
Art Unit 1648

12 November, 2004